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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,340	01/18/2002	Lou Chauvin	83304EF-P	9965

7590 02/27/2007  
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EXAMINER
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CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/051,340	<b>Applicant(s)</b> CHAUVIN ET AL.	
	<b>Examiner</b> Dohm Chankong	<b>Art Unit</b> 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1> This action is in response to Applicant's request for continued examination, filed 12.13.2006. Claims 20-22 are added. Claims 1-22 are presented for further examination.

2> This is a non-final rejection.

#### *Continued Examination Under 37 CFR 1.114*

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12.13.2006 has been entered.

#### *Response to Arguments*

4> Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5> Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/050,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims of the present application and the claims of the copending application are directed towards providing an offering based on a business relationship between a business entity and service provider.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6> Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/051,342. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims of the present application and the claims of the copending application are directed towards providing an offering based on a business relationship between a business entity and service provider.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7> Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is directed towards non-statutory subject matter because it is directed towards a computer software program *per se*. A computer program *per se* claimed without being part of a statutory manufacture or machine is considered to be nonstatutory functional descriptive material. See MPEP §2106.01(I).

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8> Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 7 lacks proper antecedent basis: "the associated service provider". This term will be interpreted by the Office as referring to the storage device provider claimed in claim 1.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9> Claims 1-3, 7, 9-13, 16-19 and 22 are rejected under 35 U.S.C §102(e) as being anticipated by Villaret et al, U.S Patent Publication no. 2002|0026367 [“Villaret”].

10> It should be noted that the recitation in the preamble of claims 1, 10 and 19 directed towards “ordering of digital photo services” is merely a statement reciting purpose or field of use. The claim limitations in the body and even in the preamble fully and intrinsically sets forth all of the limitations of the claimed invention. Since the preamble (relating to the ordering of digital photo services) merely states the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, the preamble’s statement that the method is directed towards ordering of digital photo services is considered of no significance to claim construction. See MPEP §2111.02(II).

11> As to claim 1, Villaret discloses a method for ordering of digital photo services among a plurality of order terminals each being controlled by a different one of a plurality of retail

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business entities, using a digital image provided on a digital storage device associated with one of a plurality of digital storage device providers [Figure 3 : POS terminals controlled by merchant A or merchant B], comprising:

- maintaining information with respect to business relationships between said plurality of digital storage device providers and said plurality of retail business entities [0027, 0031, 0048];

- providing a digital storage device at one of said order terminals [0025, 0027 : storing vendor applications at the terminal];

- providing an offering to a plurality of users at said one order terminal based on a business relationship between the retail business entity controlling said one order terminal and said digital device provider associated with said digital storage device [0027, 0031, 0048].

12> As to claim 2, Villaret discloses the offering includes an offering price based on said business relationship [0031 : determining a payment amount based on the merchant-vendor agreement].

13> As to claim 3, Villaret discloses said offering is displayed in a presentation format that is also based on said business relationship [0025, 0030, 0037 : the terminals configured to handle various display options including data sets from vendors that present content such as special offers, advertising or messaging].

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14> As to claim 7, Villaret discloses said digital storage device includes a code which identifies the associated service provider [0027 : "vendor code"].

15> As to claim 9, Villaret discloses the relationships are maintained in a services directory by a service manager [0027].

16> As to claim 10, Villaret discloses a system for ordering of digital photo services by a user using one order terminal from a plurality of order terminals each being associated with one of a plurality of different retail business entities, using a digital image provided on a digital storage device associated with one of a plurality of digital storage device providers [Figure 3 : POS terminals controlled by merchant A or merchant B], comprising:

maintaining information with respect to business relationships between said plurality of digital storage device providers and said plurality of retail business entities [0027, 0031, 0048], said order terminal, being used by said user, displaying an offering based on a business relationship between the retail business entity controlling said order terminal and said digital device provider associated with said digital storage device [0025, 0027, 0031, 0048], wherein offerings are not displayed when the business relationship between the retail business entity and a digital storage device provider is a hostile relationship [0025, 0027, 0038 where : a vendor that is not authorized (hostile) to access the merchant's terminal is removed from and prevented from displaying their offers on the terminal].



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17> As to claim 11, as it does not teach or further define over the limitations of claim 2, claim 11 is similarly rejected for at least the reasons set forth for claim 2.

18> As to claim 12, as it does not teach or further define over the limitations of claim 3, claim 12 is similarly rejected for at least the reasons set forth for claim 3.

19> As to claim 13, Villaret discloses the order terminal comprising a personal computer [0024].

20> As to claim 16, as it does not teach or further define over the limitations of claim 7, claim 16 is similarly rejected for at least the reasons set forth for claim 7.

21> As to claim 17, as it does not teach or further define over the limitations of claim 8, claim 17 is similarly rejected for at least the reasons set forth for claim 8.

22> As to claim 18, as it does not teach or further define over the limitations of claim 9, claim 18 is similarly rejected for at least the reasons set forth for claim 9.

23> As to claim 19, as it does not teach or further define over the limitations of claim 1, claim 19 is rejected for at least the same reasons set forth for claim 1.

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24> As to claim 22, Villaret discloses offering to the plurality of users goods and/or services of said one or more of the plurality of digital storage service providers that have established a friendly or neutral relationship with the retail business entity controlling said one order terminal [0037, 0038], while blocking access to said one or more of the plurality of digital storage device providers which have a hostile relationship with retail business entity [0025, 0027, 0038].

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25> Claims 4, 8 and 21 are rejected under 35 U.S.C §103(a) as being unpatentable over Villaret.

26> As to claim 4, Villaret does not expressly disclose that the terminal is an automated teller machine. It would have been obvious to one of ordinary skill in the art to incorporate automated teller machines into Villaret's invention as part of his disclosed electronic appliances [0047]. One would have been motivated to incorporate the ATMs into Villaret to as Villaret discloses his terminals are generally electronic funds transaction point of sale

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(ETPOS) terminals, including those that can read cards like ATM cards [0025]1. ATMs are classified as ETPOS terminals.

27> As to claim 8, Villaret does not expressly disclose friendly, neutral or hostile relationships. However Villaret discloses analogous concepts in the relationship between the merchants and the vendors in his invention. For example, Villaret discloses that vendors may or may not be authorized to sell their certain products or services on the terminal [0025, 0027, 0038 : vendors that are authorized to communicate with the terminal, preventing unauthorized vendor applications from operating on the terminal]. The Office interprets the relationship between the vendor-merchant when the vendor and its applications are not authorized to access the terminal as a hostile relationship. The Office interprets the vendor-merchant relationship when the vendor and its applications are authorized to access the terminal as a neutral relationship.

Finally, Villaret also discloses that the vendor can offer special offers such as discounts to the merchant (to subsequently offer to the customer) [0037 : "special offers being made available by the vendor to the merchant"]. This vendor-merchant relationship is considered to be analogous to a friendly relationship.

28> As to claim 21, Villaret discloses offering to the plurality of users goods and/or services of said one or more of the plurality of digital storage service providers that have established a friendly or neutral relationship with the retail business entity controlling said one order terminal [0037, 0038], while blocking access to said one or more of the plurality of

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digital storage device providers which have a hostile relationship with retail business entity [0025, 0027, 0038].

29> Claims 5, 6, 14, 15 and 20 are rejected under 35 U.S.C §103(a) as being unpatentable over Villaret, in view of Chui et al, U.S Patent No. 6,657,702 ["Chui"].

30> Chui was cited by the Office in PTO-892, filed 12.15.2005.

31> As to claims 5 and 14, Villaret does not expressly disclose the digital storage device comprising one of: optical disk, floppy disk, memory card or a digital camera. As to claims 6 and 15, Villaret does not expressly disclose that the terminal provides access to one of the following services: local printing, remote printing or online storage of digital images, providing digital storage media containing digital images or providing goods and services with respect to hard-copy prints.

32> In the same field of invention, Chui is directed towards a system whereby users can order services from a POS system such as a photo kiosk located in a store [column 7 «lines 12-25»]. As to claims 5 and 14, Chui discloses that the kiosk includes digital cameras, CD-ROM, a diskette or flash memory card [column 5 «lines 14-29» | column 7 «lines 26-32»]. As to claims 6 and 15, Chui further discloses providing printing services of digital images and providing storage of digital images [abstract | column 3 «lines 24-32» | column 13 «lines 22-35»].

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It would have been obvious to one of ordinary skill in the art to incorporate Schultz's teachings of a photo kiosk and digital camera into Villaret's POS system. There is a reasonable expectation of success because Villaret's invention is directed towards providing a variety of services through the terminals, such as purchasing tickets [0026] and Schultz's functionality is akin to downloading non-payment applications into the Villaret's kiosk [see Villaret, 0027]. Thus, one would have been motivated to modify Villaret's kiosk and digital storage media to be a photo kiosk and digital camera, respectively to increase the functionality of Villaret's system by enabling ordering of photos through the kiosks.

33> As to claim 20, Villaret does not expressly disclose a photo kiosk. As discussed above, Chui discloses a photo kiosk [column 7 «lines 12-25»]. It would have been obvious to modify Villaret's kiosk to be a photo kiosk to increase the functionality of Villaret's system by enabling users to access photo printing services as taught by Chui.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gell et al, U.S Patent No. 5,802,502;

Sheth, U.S Patent Publication No. 2001|0032170;

Shiota et al, U.S Patent No. 6,324,521;

Powers, U.S Patent Publication No. 2001|0054004;

Holden et al, U.S Patent Publication No. 2002|0002579;

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Gonzalez et al, U.S Patent Publication No. 2002|0019786;

Owens, U.S Patent Publication No. 2003|0004831;

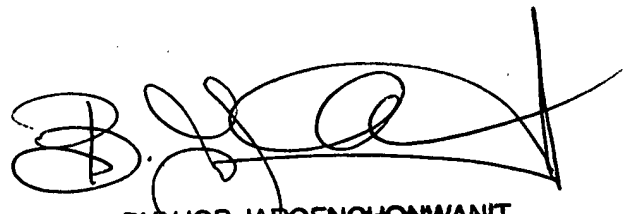
D'Antoni et al, U.S Patent Publication No. 2003|0139996.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



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SUPERVISORY PATENT EXAMINER